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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,310	01/21/2000	Gary Stephenson	7922	5677
27752 7590 12/09/2011 THE PROCTER & GAMBLE COMPANY Global Legal Department - IP Sycamore Building - 4th Floor 299 East Sixth Street CINCINNATI, OH 45202				
EXAMINER				
ROBERTS, LEZAH				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
12/09/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/489,310

Applicant(s)

STEPHENSON, GARY

Examiner

LEZAH ROBERTS

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 4, 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 23 and 25-31 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 23 and 25-31 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Applicants' arguments, filed October 4, 2011, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims

Claim Rejections - 35 USC § 103 – Obviousness

Claims 23-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kohl et al. (USP 3,681,091) as evidenced by Grunberg et al. (Scandinavian Journal of Nutrition/Naringsforsking). Claim 24 is cancelled.

The rejection has been reiterated below, wherein the rejection has been modified to encompass the instant claims and not previously cancelled claims.

Rejection

The prior art discloses fruit juices which comprise 0.1 to 5 weight percent linear sodium or potassium polyphosphates having 14 to 100 repeating units (preferably 16 to 37). See the passage spanning col. 1, lines 60 to col. 2, line 9, and see also the

passage spanning col. 2, line 51 to col. 2, line 6. Note also that the working examples comprehensively test polyphosphates having various specific chain lengths within that range. (See especially Table VIII and XI following cols. 13 and 14). The juices are acidic in nature, having low pH's. See Example 24 at col. 13 (orange juice having pH 4.10) and col. 15, line 11 (apple cider having pH 3.6, which anticipates "about" 3.5 as recited by instant claim 18). The prior art compositions do not appear to contain any substantial quantities of calcium, fluoride or orthophosphate. Regarding the requirement of instant claims 13, 19, 25 and 30, it is self-evident that fruit juices such as apple and orange already contain, inherently and naturally, sweeteners within the range of 0.1 to 20 percent by weight.

Kohl et al differs from the instant claims insofar as it does not disclose the directing step of the instant claims.

The Board of Appeals states "The Appellant recognizes that the average consumer of an acidic beverage, e.g., a cola product, appreciates the need for enamel erosion control." Therefore the Board of Appeals concludes "it is reasonable to find that the average consumer of the acidic beverages of the prior art would also appreciate the need for enamel erosion control and thus be "in need of" enamel erosion control". See Decision page 7, paragraph 2. Based on the above recognition/appreciation, it would have been obvious to have been "directed" to drink the prior art beverages for that purpose.

Applicant's Arguments

Applicant argues that all previous arguments in support of patentability continue to apply, but will not be repeated herein for the sake of brevity.

Applicant further argues that it is entirely counter-intuitive and, hence, non-obvious, to use an acidic beverage of the present type to treat teeth that have been eroded by acid. Moreover, the Examiner's attention is directed to the fact that this is not simply a case of attempting to claim a newly discovered result of a known process. The claimed method for treating dental erosion caused by exposure of the teeth to acid requires a particular patient population and a particular type and amount of phosphate agent that is administered to such patient population at an acidic pH, neither of which are explicitly or inherently disclosed by the combination of cited documents. It is bedrock principle of patent law that new uses of old products or processes are patentable subject matter. Indeed, if anyone ever corrected tooth erosion by using the '091 method, alone or with Grunberg, it could only be considered accidental. It is well-established that an accidental or unwitting duplication of an invention cannot constitute anticipation. In short, since the cited documents, alone or in combination, do not suggest treating the patient population herein using an acidic, phosphate-containing composition, it is submitted that all claims meet the requirement of 103.

Examiner's Response

The Examiner submits that all previous responses to Applicant's previous arguments continue to apply.

The Examiner submits that although the claims are amended, the instant claims read on an individual imbibing the juices of Kohl for other purposes. Erosion of the teeth is primarily caused by acid from food. Therefore a patient with natural teeth would have some erosion caused by acid over the course of their lives and would be considered the patient population encompassed by the instant claims. Thus the claims still encompass all individuals with natural teeth who drink acidic beverages every day, such as the acidic beverages of the prior art, as indicated in the Board Decision page 7, paragraph 2. Further the claims do not recite any components that are incorporated into the beverages that would distinguish the beverage of the instant claims from the juices of Kohl. Further, the polyphosphates used in Kohl are encompassed by the instant claims and the instant claims do not recite a specific amount of polyphosphates. Therefore the claims still read on the patient population that drinks apple juice everyday having natural teeth. Further although the reference does not explicitly state dental erosion, the same method steps used for treating dental erosion of the instant claims are the same steps one would use to drink apple juice. Considering, as stated above, that all persons with natural teeth would be in need of treatment of dental erosion because of food, the claims are not distinguished from the prior art.

Conclusion

Claims 23 and 25-31 are rejected.

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Primary Examiner, Art Unit 1612